REMARKS

Claim Status

Applicants acknowledge, with appreciation, the indication that claims 4-6, 8-10 and 12 contain allowable subject matter. Claims 1-19 are currently pending, with claims 1, 11, 13, 16 and 19 being in independent form. Claims 1 and 11 have been amended. Support for the amendments to independent claims 1 and 11 may be found, for example, in Fig. 2 and at paragraphs [0010], [0046] and [0067] of U.S. Pub. No 2006/0224460 (i.e., the "published application"). New independent claims 13, 16 and 19 have been added. New dependent claims 14, 15, 17 and 18 have been added. No new matter has been added. Reconsideration of the application, as herein amended, is requested.

Overview of the Office Action

Claims 1, 7 and 11 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Pub. No. 2002/0067500 ("*Yokomizo*") in view of U.S. Patent No. 6,344,853 ("*Knight*"). Claims 2 and 3 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Yokomizo* in view of *Knight*, and further in view of U.S. Patent No. 4,751,507 ("*Hama*").

Applicants have carefully considered the Examiner's rejection, and the comments provided in support thereof. For the following reasons, applicants respectfully assert that all claims now pending in the present application are patentable over the cited art.

Patentability of Independent Claims 1 and 11 under 35 U.S.C. §103(a)

The present application explains that "the customer implements the authentication by the given authenticator and the update of the window in the user terminal 3 to operate so as to

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display the correction window 221, the control section 21 of the server 2 receives this operation" (see paragraph [0066] of the published application). As further explained at paragraph [0067] of the published application, "when wanting to confirm the portion on which "Sample" is superimposed during the confirmation of the whole edit image, the customer clicks the move button 221g. The control section 21 receives this operation". As additionally explained at paragraph [0068], "when the customer clicks the partial display button 221c so as to change the display condition to the partial display, the control section 21 receives this operation.... Further, when the customer clicks the window scroll button 221h of the desired direction, the control section 21 receives this operation". The confirmation operation is further explained at paragraph [0071] of the published application, where it is explained that "[a]fter having made the correction as described above and confirmed that there is no problem in the edit image, the customer clicks the OK button 221d, and the control section 21 of the server 2 received this operation and then the correction is completed. When any modification exists, the customer writes the modification content in the text input field 221f and clicks the modify button 221e, and the control section 21 of the server 2 receives this operation. Subsequently, the operations of the edit image modification by the designer and the correction by the administrator and the customer are repeated".

Independent claim 1 has been amended to recite, *inter alia*, "a control section configured to receive the display condition input by the user terminal and to confirm changes of a display state of the second image in relation to the first image". Independent method claim 11 has been amended to recite a corresponding limitation. Support of the amendments may be found, for example, in Fig. 2 and at paragraphs [0010], [0046] and [0067] of the published version of the

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present application. No new matter has been added. The Examiner-cited art fails to teach or suggest this expressly-subject matter.

The Examiner (at pg. 4 of the Final Office Action) has acknowledged the failure of *Yokomizo* to teach "a second image generating section for generating a second image regard to the first image based on the display condition inputted by the user terminal; and, a window information generating section for displaying the first image and the second image simultaneously". The Examiner cites *Knight* in an attempt to cure the shortcomings of *Yokomizo* and, thereby, render independent claims 1 and 11 unpatentable.

Applicants disagree, however, that any proper combination of *Yokomizo* and *Knight* achieve applicants' claimed invention, because *Yokomizo* and *Knight* fail to teach or suggest a server including the control section of independent claim 1 that is configured to receive the display condition input by the user terminal and to confirm changes of a display state of the second image in relation to the first image, as correspondingly recited in amended independent claim 11.

Yokomizo relates to a "service in which silver-salt photographic pictures or images are transmitted, displayed, edited and printed at practically acceptable fees, by using communication lines such as telephone lines or ISDN lines which can easily be used at household economy levels" (see paragraph [0011]). *Yokomizo* fails to teach or suggest the server of now amended independent claim 1 and the corresponding method step of now amended independent claim 11.

Yokomizo (paragraph [0047]) explains that "low-resolution image information alone, formed from the high-resolution image information, is uploaded in the web server 9 at the head shop 5.... Upon receipt of a request from the user 7 for sending the stored image, the web server 9 at the head shop 5 sends the low-resolution image information to the user 7 through the

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network. The user then effects desired editorial works on the low-resolution image information thus received by the personal computer of the user's own". This section of *Yokomizo* teaches that the server 9 receives requests for the download of stored images.

Yokomizo discloses a system that provides for status inquiries at a head shop provided with a server 9. As explained at paragraph [0212] of *Yokomizo*, "the head shop is most administrative. The operation support tools assist the server administrator of the head shop in making investigation of the statuses of the branch shops or in aiding the branch shops through the network. An on-line access by a specific protocol is possible to branch shops which are connected to the head shop through exclusive lines". This section of *Yokomizo* merely teaches that the server 9 is configured to permit a user to make status requests regarding their orders.

Thus, *Yokomizo* fails to teach or suggest a server including the control section of independent claim 1 that is configured to receive the display condition input by the user terminal and to confirm changes of a display state of the second image in relation to the first image, as correspondingly recited in amended independent claim 11.

Knight fails to disclose what *Yokomizo* lacks. *Knight* relates to digitally processing and superimposing "a second image on a first image and to display the composite image, whereby a prospective purchaser can preview the product bearing the logo represented by the composite image" (see col. 3, lines 2-7). *Knight* merely explains that the composite images are superimposed one above the other. Moreover, *Knight* teaches that the second image is fixedly superimposed over the first image. There is no provision in *Knight* for changing the position of the second image in relation to the first image. That is, *Knight* fails to teach or suggest a server including "a control section configured to receive the display condition input by the user terminal and to change a display state of the second image in relation to the first image", as recited in

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amended independent claim 1 and correspondingly recited in amended independent method claim 11.

Thus, the combination of *Yokomizo* and *Knight* fails to achieve a system that encompasses the advantageous features and functionality of the above-cited claim limitations. There is no control section provided by the combination of *Yokomizo* and *Knight* that is configured to implement these advantageous features and functionality. Indeed, the teachings of *Knight* provides the skilled person with no motivation or reason to modify the structure of *Yokomizo* to achieve applicants' claimed invention, absent an impermissible artificial hindsight construction based on applicants' own disclosure. The expressly-recited subject matter of now-amended independent claims 1 and 11 is accordingly patentable over the cited art for *at least* this reason.

In view of the foregoing, reconsideration and withdrawal of the rejection of independent claims 1 and 11 under 35 U.S.C. §103 are thus deemed to be in order, and early notice to that effect is solicited.

New Independent Claims 13, 16 and 19

New independent claim 13 includes the subject matter of originally filed independent claim 1 and dependent claim 4. New independent claim 16 includes the subject matter of originally filed independent claim 1 and dependent claim 8. New independent claim 19 includes the subject matter of originally filed independent claim 11 and dependent claim 12. Since dependent claims 4, 8 and 12 were indicated to contain allowable subject matter, as noted above, new independent claims 13, 16 and 19 are deemed to be allowable.

Patentability of Dependent Claims 2 and 3 under 35 U.S.C. §103(a)

The Examiner (at pg. 4 of the Final Office Action) acknowledges that the combination of *Yokomizo* and *Knight* fails to teach or suggest "a display section for displaying the first image can select either a whole display or a partial display on the display window of the user terminal; wherein the window information generating section for displaying the first image and the second image simultaneously when the whole display is selected by the user terminal, while displaying a portion of the first image when the partial display is selected by the user terminal" as recited in dependent claim 2, and "the window information generating section comprising a soft-key for changing the display portion of the first image when partial display is selected by the user terminal, updating the window information in response to an input using the soft-key by the user terminal, and changing and displaying the display portion of the first image", as recited in dependent claim 3, and cites *Hama* for these features.

Applicants, however, contend that no proper combination of *Yokomizo*, *Knight* and/or *Hama* achieves the subject matter of independent claim 1, from which claims 2 and 3 depend. There is simply nothing in *Hama* to cure the above-discussed deficiencies in *Yokomizo* and *Knight*, e.g., the lack of teachings relating to applicants' claimed control generating section as recited in independent claim 1.

Hama discloses "[a] method ... for creating simultaneously viewable coarse and fine resolution displays, respectively presenting an 'entire image' with coarse resolution of detail and a selected portion of that image in an enlarged view with fine resolution of detail" (see Abstract and col. 1, lines 13-22). *Hama* fails to teach or suggest what *Yokomizo* and *Knight* lack. The system achieved by the combination of *Yokomizo*, *Knight* and *Hama* thus fails to achieve the expressly-recited subject matter of independent claim 1. There is simply no reason for the

skilled person to combine the teachings of *Yokomizo* or *Knight* with the teachings of *Hama* to achieve applicants claimed system, absent an impermissible hindsight construction.

The combination of *Yokomizo, Knight* and/or *Hama* thus fails to teach or suggest the express recitations of applicants' independent claim 1. Since *Yokomizo, Knight* and *Hama*, individually or in combination, fail to teach or suggest the features recited in independent claim 1, dependent claims 2 and 3 are deemed to be patentable based *at least* on their dependency from claim 1.

Dependent Claims

In view of the patentability of independent claims 1, 11, 13 and 16, for the reasons presented above, each of dependent claims 2-10 and 12, as well as new dependent claims 14, 15, 17 and 18, is respectfully deemed to be patentable therewith over the prior art. Moreover, each of these claims includes features which serve to still further distinguish the claimed invention over the applied art.

Conclusion

Based on all of the above, applicants submit that the present application is now in full and proper condition for allowance. Prompt and favorable action to this effect, and early passage of the application to issue, are once more solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned to facilitate an early resolution of any outstanding issues.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
COZEN O'CONNOR

By   /Alfred W. Froebrich/
Alfred W. Froebrich
Reg. No. 38,887
277 Park Avenue
New York, New York 10172
(212) 883-4900

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